

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL A. NEPELA,
ERICH P. VALSTYN and
DEREK J. KROES

Appeal No. 1997-3962
Application 08/500,741¹

ON BRIEF

Before JERRY SMITH, BARRETT and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed July 11, 1995. According to applicants, this application is a continuation-in-part of Application 08/387,395, filed February 13, 1995; which is a continuation of Application 08/103,669, filed August 10, 1993.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2, 3 and 5-9, which constituted all the claims remaining in the application. An amendment after final rejection was filed on July 9, 1996 and was entered by the examiner. This amendment cancelled claims 2, 3 and 5. Therefore, this appeal is directed to the rejection of claims 6-9 which are all the claims remaining in this application. A declaration was also filed after final rejection which was also entered by the examiner [advisory action mailed August 6, 1996].

The disclosed invention pertains to a thin film read-write magnetic head for recording and reproducing information on a magnetic medium.

Representative claim 8 is reproduced as follows:

8. A thin film read-write magnetic head for use with a magnetic medium on which data tracks are recorded and read out comprising:

first and second magnetic layers for forming a magnetic yoke with a nonmagnetic transducing gap and having at least three separate closely spaced sections, all of said three sections each being formed of material having substantially the same magnetic reluctance, wherein the total width of said nonmagnetic transducing gap defined by said three sections delineates the total width of said recorded data tracks, the

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center section of at least one of said layers having an interspace formed therein;

flux sensing means disposed within said interspace for sensing a readout signal;

write coil means disposed between said first and said second magnetic layers;

magnetic valve conductor means coupled to said magnetic yoke adjacent said flux sensing means;

said magnetic valve conductor means being disposed between said write coil means and said flux sensing means; and

means for magnetically saturating said magnetic valve conductor means during sensing of said readout signal and for providing a magnetic shunt around said flux sensing means during signal recording by said write coil means.

The examiner relies on the following references:

Fukazawa et al. (Fukazawa)	5,097,372	Mar. 17, 1992
Valstyn et al. (Valstyn)	5,255,141	Oct. 19, 1993

Claims 6-9 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Valstyn in view of Fukazawa.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 6-9. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d

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1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 8 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,

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664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 8, the examiner cites Valstyn as teaching a thin film read-write

magnetic head having most of the elements recited in claim 8. The examiner notes that Valstyn does not disclose a yoke having three separate closely spaced sections. Fukazawa is cited as teaching a thin film read-write magnetic head in which the yoke is made up of three or more sections for providing a wide writing area and a narrower reproducing area. The examiner observes that it would have been obvious to use the three yoke sections of Fukazawa with the magnetic head of Valstyn because it would greatly enhance the off-track reproducing of a thin film magnetic head as suggested by Fukazawa [answer, pages 3-5]. The examiner also notes that the combination of Fukazawa and Valstyn does not show the valve conductor means being disposed between the write coil means and the flux sensing means as claimed. The examiner finds that it would have been obvious to dispose the valve conductor means as claimed for several general reasons and because no new or unexpected results are obtained [id., page 6].

Appellants basically rely on two separate arguments to demonstrate error in the examiner's rejection. First, appellants argue that the device of Fukazawa is

inoperative to perform as set forth in the Fukazawa patent [brief, pages 6-11]. A declaration by Dr. Samuel W. Yuan has been filed in support of this position. Second, appellants argue that even if the teachings of Fukazawa are combined with the teachings of Valstyn, there is no suggestion within the applied references of the claimed location of the magnetic valve conductor means [id., pages 12-17]. We consider the second argument first.

As noted above, the examiner admits in the rejection that the combined teachings of Valstyn and Fukazawa specifically show the coil means and flux sensing means being located on the same side of the valve conductor means [note Figure 1 of Valstyn]. The examiner simply asserts that the claimed location of the valve conductor means between the coil means and the flux sensing means would have been obvious because of several alleged advantages and because an equivalent result is achieved with no unexpected properties. This rejection cannot stand because the examiner has provided no evidence to support his conclusions of obviousness.

The fact that a rearrangement of parts of a prior art device may result in a device that operates in the same manner is not, by itself, evidence of obviousness. The examiner must still demonstrate why the artisan would have been motivated to modify the prior art. Here, the examiner's reasons are based on pure speculation such as an increase in manufacturing yield. There is absolutely no evidence on this record to support such assertions by the examiner. Since the evidentiary record before us does not support the examiner's conclusion of obviousness, we do not sustain the examiner's rejection of claims 6-9 under 35 U.S.C. § 103.

Since the combination of Valstyn and Fukazawa would not have suggested the obviousness of the claimed invention, we need not dwell on the merits of appellants' argument that the device of Fukazawa is inoperable. We simply note for the record that a patent is presumed to be valid, and the burden of proving that a patent is inoperable, and therefore invalid, is an extremely heavy one. Arguments of appellants' representative and the opinion of Dr. Yuan that the Fukazawa device does not effectively operate would not have been

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sufficient to meet this heavy burden. As noted above,
however, determination of this question is not necessary to
dispose of this appeal.

In summary, we have not sustained the examiner's
rejection of claims 6-9. Therefore, the decision of the
examiner rejecting claims 6-9 is reversed.

REVERSED

	Jerry Smith)	
	Administrative Patent Judge)	
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)	
	Lee E. Barrett)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
	Lance Leonard Barry)	
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